

## REMARKS

Applicants have carefully reviewed the Office Action dated March 31, 2006.

Claims 1-9 stand rejected under 35 USC § 103(a) as being unpatentable over *Perkowski*, USP 6,064,979, in view of *Wilz, Sr. et al.*, USP 6,394,354. This rejection is respectfully traversed with respect to the claims a presently presented.

The Examiner has repeated the rejection in view of the *Perkowski* reference that has been previously discussed. The remarks with respect to this rejection are incorporated herein and will not be discussed further in this action. The Examiner in this action has noted that one aspect of *Perkowski* that is not taught is that it does not explicitly teach the visual indicia associated with a routing system and indicates that scanning of the machine readable code will cause computer based access of the network. Applicants disagree that this is the only aspect lacking in *Perkowski*, but will discuss this additional reference in that light. The *Wilz* reference, in accordance with the Examiner's rejection, teaches a URL encoded bar code symbol printed above each Web-site URL to indicate that scanning of the URL barcode symbol will cause computer based access. The Examiner relies on the *Wilz* reference at Col. 2, line 49 – Col. 3, line 12; Col. 7, lines 20-40; Col. 16, line 61 – Col. 17, line 18.

Prior to discussing this combination, Applicants wish to bring to the Examiner's attention the current case law on determining obviousness. This is *Alza Corporation v. Mylan Laboratories, Inc.*, Fed. Cir., No. 06-1019, 9/6/06.

In the *Alza* opinion, the Federal Circuit has responded to arguments made in a pending Supreme Court case, and has spelled out its law on obviousness, insisting that it is in harmony with Supreme Court precedent.

In the facts of this case, Alza sued Mylan for infringement of its patent (6,124,355) under 35 U.S.C. §271(e)(2) after Mylan sought FDA approval to market a generic version of oxybutynin,

a drug used to treat urinary incontinence. The Federal Circuit affirmed the obviousness and non-infringement decisions of the district court.

In the process, Judge Arthur Gajarsa dedicated five pages of his opinion to outline the Federal Circuit's law on obviousness, responding to many arguments made in the pending Supreme Court case of *KSR Int'l Co. v. Teleflex, Inc.* (U.S. No. 04-1350). KSR and many amici, including the U.S. government, have challenged the Federal Circuit rule that proof of obviousness must include a showing of a "teaching, suggestion, or motivation" to combine the prior art elements of the claimed invention. KSR and others have said that this requirement is too rigid and is inconsistent with Supreme Court decisions issued since *Graham v. John Deere Co.*, 383 U.S. 1 (1966)

Judge Gajarsa wrote the following in his *Alza* opinion:

This requirement has been developed consistent with the Supreme Court's obviousness jurisprudence as expressed in *Graham* and the text of the obviousness statute that directs us to conduct the obviousness inquiry "at the time the invention was made" 35 U.S.C. §103. As we explained in [*In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006)],

The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the *Graham* analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law . . . .

441 F.3d at 987. We further explained that the "motivation to combine" requirement "[e]ntails consideration of both the 'scope and content of the prior art' and 'level of ordinary skill in the pertinent art' aspects of the *Graham* test." *Id.* at 986.

At its core, our anti-hindsight jurisprudence is a test that rests on the unremarkable premise that legal determinations of obviousness, as with such determinations generally, should be based on evidence rather than on mere speculation or conjecture. Our court's analysis in *Kahn* bears repeating:

A suggestion, teaching, or motivation to combine the relevant prior art teachings *does not have to be found explicitly in the prior art*, as “the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references.... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be *some* articulated reasoning with *some* rational underpinning to support the legal conclusion of obviousness. This requirement is as much rooted in the Administrative Procedure Act [for our review of Board determinations], which ensures due process and non-arbitrary decisionmaking, as it is in § 103.

441 F.3d at 987-88 (quoting *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000)) (citations omitted) (emphases added)). There is flexibility in our obviousness jurisprudence because a motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires an actual teaching to combine before concluding that one of ordinary skill in the art would know to combine references. This approach, moreover, does not exist merely in theory but in practice, as well. Our recent decisions in *Kahn* and in [*Cross Med. Prods., Inc., v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293 (Fed. Cir. 2005)] amply illustrate the current state of this court’s views.

Applicants believe that the Examiner’s combination of and *Wilz* and *Perkowski* is conclusory, as the problem solved by *Wilz* is not to have the web indicia embedded within the barcode or in proximity thereto. Rather, there is a non-indicative symbol or barcode as to location provided that allows an individual to access a broader ranger of locations than could be provided on the face of the document. Further, without scanning the code, the user could not access the code, whereas in *Wilz*, they can read the URL and merely typing that in instead of scanning it. The scanning is just merely a way to facilitate input, as opposed to providing a means by which a third party can provide a service to allow access of a non-descript indicia or barcode for routing. As such, Applicant believes that the *Perkowski* and *Wilz* references, taken either in combination or singularly, do not obviate or anticipate Applicants’ present inventive concept, as defined by the presently presented claims. Therefore, Applicants respectfully request withdrawal of the 35 USC § 103(a) rejection with respect to Claims 1-9.

Applicants have now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicants respectfully request full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/PHLY-24,740 of HOWISON & ARNOTT, L.L.P.

Respectfully submitted,  
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